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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,127	05/31/2006	Kikue Hayashihara	HAYASHIHARA ET AL-1 PCT	2612
25889	7590	05/22/2008	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			ABU ALI, SHUANGYI	
			ART UNIT	PAPER NUMBER
			1793	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,127	Applicant(s) HAYASHIHARA ET AL.	
	Examiner SHUANGYI ABU ALI	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/06/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3, what is the equivalent material cited in the claims 1-3? The phrase "equivalent" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 1-2, the phrase "clay-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "clay-like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Titanium cited in claim 4 is indefinite because the examiner is unclear as to if this is titanium element or titanium oxide? The Examiner treats the titanium as titanium oxide pigment.

Regarding claims 1, 2, 3 and 5, the term "fine" is indefinite because the examiner is unclear as to what this means. It is referring to the size and if so what is the size (numerical value).

Regarding claim 7, it is not clear what does 50 to 150 fine powder mean?

Regarding claims 1-3 the phrase "comprising vegetable material including wood" is indefinite because the examiner is unclear as to if wood is part of the claimed invention or not. A broad limitation (i.e. vegetable matter) together with a narrow limitation (wood) that falls

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within the broad limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c).

The other claims are indefinite because they depend on indefinite claims

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

It is noted that claims 1-8 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 77F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985) (citations omitted).

Claims 1-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 47046212, in view of U. S. patent No. 4, 792,357 to Bier.

Regarding claims 1-3 and 5, '212 disclose a paint composition comprising wood powder, CMC, PVA, pigment and water et al. But they are silent about the composition comprising alginate as applicant set forth in claims 1-3.

However, it would have been obvious to one of ordinary skill in the art to use alginate in the 212' paint composition, motivated by the fact that Bier, also drawn to a paint composition, discloses that water soluble binder such as cellulose, PVA and alginates are used in the paint composition (col. 4, lines 21-40) and it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material (mixture of CMC and alginate) that is to be used for the same purpose (i.e. as a water soluble binder). In re Kerkhoven 205 USPQ 1069.

Regarding claim 4, Bier discloses that titanium oxide is used as pigment in the paint composition (example 7).

Regarding claim 7, '121 discloses the wood powder has a size of less than 0.3 mm (claim 1).

Regarding claim 8, '121 discloses that the paint composition is stored in a container (Page 3, lines 20-23).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of JP 47046212, in view of U. S. Patent No. 4, 792,357 to Bier, further in view of FR 2567795.

Regarding claim 6, combined teaching of '212 and Bier disclose a composition as applicant set forth in claim 1, but they are silent about the origin of the sawdust as applicant sets forth in claim 5.

However, it would have been obvious to one of ordinary skill in the art to use the sawdust as applicant sets forth in claim 6, motivated by the fact that '795, also drawn to a coating composition, discloses that oak sawdust, as is a known wood powder, is used in the coating composition (abstract).

Conclusion

The references on the 892 are cited as art of interest because they are cumulative or less than the art relied in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793

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